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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/070,106	02/27/2002	Tomihisa Kamađa	Y-201	9582

802 7590 11/24/2006

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PORTLAND, OR 97282-0788

EXAMINER

HASHEM, LISA

ART UNIT PAPER NUMBER

2614

DATE MAILED: 11/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/070,106

Applicant(s)

KAMADA, TOMIHISA

Examiner

Lisa Hashem

Art Unit

2614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) 5-7 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 8-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Applicant's election with traverse of claims 1-4 and 8-15 in the reply filed on 9-6-06 is acknowledged.

The traversal is on the ground(s) that the searches and examination would be similar and that it is unfair to applicant since significant examination has already been made on the full claim set. This is not found persuasive because as stated in the Restriction requirement filed on 8-7-06 Group 1: claims 1-4 and 8-15 are drawn to storing software for a portable data terminal into a dedicated storage area of a user on a storage server and this is classified differently than Group 2: claim 5-7 which are drawn to a software sales method wherein a user purchases software or is charged for software use. Thus, the search and examination would not be similar.

Although significant examination has already been made by the Examiner, there is still serious burden on the Examiner in examining the two groups of claims; for example, wherein claim 1 recites 'providing a storage area in a storage server for a portable data terminal', this limitation is not cited in the second group of claims and would be examined under class 455 of telecommunications.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claim 13 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claim includes the following language: '...A computer

Art Unit: 2614

program that runs on a portable data terminal...'. The computer program must be stored on a computer readable medium in order for it to be statutory.

Claim Objections

4. Claim 8 recites the limitation "the dedicated storage areas of the user". There is insufficient antecedent basis for this limitation in the claim.
5. Claim 11 recites the limitation "the user". There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-4 and 12-15 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by U.S. Pat. No. 6,832,230 by Zilliacus et al, hereinafter Zilliacus.

Regarding claim 1, Zilliacus discloses a method for providing a storage area in a storage server (e.g. PC) for a portable data terminal (Fig. 1, 110; Fig. 2, 210) connected over a network (Figs. 1, 2; col. 5, lines 38-40; col. 6, lines 1-17), said method comprising the steps of: allocating a uniquely dedicated storage area for each user (col. 6, lines 1-17) (e.g. user of the mobile terminal uses a PC for a downloading service); storing software, which is purchase-requested at a software sales site on the network by a user into the dedicated storage area allocated uniquely to the user of the storage server without

Art Unit: 2614

sending the software from the site directly to a portable data terminal of the user (col. 6, lines 1-17; col. 7, lines 1-15); and
making available the software, stored in the dedicated storage area in said storage server, to the user in response to a request from the user (col. 7, lines 11-15; col. 8, lines 29-38).

Regarding claim 2, the method for providing a storage area according to claim 1, wherein Zilliacus further discloses an expiration date until which the user is allowed to use the software stored in said storage server is set,
further comprising the step of making the software, which is in the dedicated storage area, unavailable to the user after the expiration date (e.g. wherein the application will delete itself automatically, even if the application is stored on the PC because the application is formatted with a lifetime) (col. 6, lines 1-67; col. 7, line 50).

Regarding claim 3, the method for providing a storage area according to claim 1, wherein Zilliacus further discloses further comprising the step of charging the user for the purchase-requested software when the purchase-request is made,
when the user downloads the software from the dedicated storage area, or
when the user indicates an intention to continue to use after a trial period passes after the downloading (col. 8, lines 29-38; col. 8, lines 45-51).

Regarding claim 4, the method for providing a storage area according to claim 1, wherein Zilliacus further discloses further comprising the steps of:
storing software, which is not purchase-requested by the user (e.g. initially downloading an application without a fee), into the dedicated storage area (e.g. PC);
allowing the user to select the software not purchase-requested; and

Art Unit: 2614

charging the user for the software when the user downloads the selected software or when the user indicates an intention to continue to use after a trial period (e.g. downloading the same application on a different occasion for a reduced fee) (col. 7, line 27 – col. 8, line 37; col. 8, line 61 – col. 9, line 5).

Regarding claim 12, Zilliacus discloses a recording medium (Fig. 2, 214) storing therein a computer program that runs on a portable data terminal (Fig. 1, 110; Fig. 2, 210) with a network connection capability (col. 5, lines 10-16; col. 5, lines 38-40; col. 6, lines 14-17), said computer program comprising:

a function that downloads required software from full-set software into local storage (Fig. 1, 112; Fig. 2, 212) as required, said full-set software being stored in a dedicated storage area allocated on a storage unit on a network (Fig. 1, 120; Fig. 2, 242) (col. 5, lines 6-10; col. 7, line 1 – col. 8, line 3);

a function that manages expiration date information that is set for the software stored in the local storage; and

a function that automatically erase the software from said local storage when the expiration date defined by the expiration date information has passed (col. 6, lines 18-67; col. 7, line 50- col. 8, line 3).

Regarding claim 13, Zilliacus discloses a computer program that runs on a portable data terminal (Fig. 1, 110; Fig. 2, 210) with a network connection capability (col. 5, lines 10-16; col. 5, lines 38-40; col. 6, lines 14-17), said computer program comprising:

a function that downloads required software from full-set software into local storage (Fig. 1, 112; Fig. 2, 212) as required, said full-set software being stored in a dedicated storage area allocated

Art Unit: 2614

on a storage unit on a network (Fig. 1, 120; Fig. 2, 242) (col. 5, lines 6-10; col. 7, line 1 – col. 8, line 3);

a function that manages expiration date information that is set for the software stored in the local storage; and a function that automatically erase the software from said local storage when the expiration date defined by the expiration date information has passed (col. 6, lines 18-67; col. 7, line 50- col. 8, line 3).

Regarding claim 14, the method for providing a storage area according to claim 1, wherein Zilliacus further discloses further comprising the steps of:

accepting a purchase request of software from the user at the software sales site; and

receiving, according to said purchase request,

the purchase-requested software or identification information associated therewith at a site of said storage server such that said purchase-requested software or identification information associated therewith is stored into said dedicated storage area allocated to the user

(col. 6, lines 1-17; col. 7, lines 1-15; col. 8, lines 23-38).

Regarding claim 15, the method for providing a storage area according to claim 1, wherein Zilliacus further discloses said step of storing software into a dedicated storage area allocated uniquely, is performed after the software is purchase-requested at a software sales site on the network by the user (col. 6, lines 1-17; col. 7, lines 1-15; col. 8, lines 23-38).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 8-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zilliacus in further view of U.S. Pat. No. 6,308,061 by Criss et al, hereinafter Criss.

Regarding claim 8, Criss further discloses a storage server (e.g. host server) (Fig. 1: 30; col. 7, lines 1-14) connected to portable data terminals (Fig. 1, 36; col. 6, lines 1-11) over a network (Fig. 1), said storage server comprising:

a storage unit (Fig. 3b, 67) having dedicated storage areas, each uniquely allocated to an individual user of a portable data terminal (Fig. 4; col. 9, lines 57-67) (e.g. wherein each portable data terminal, for example: mobile terminal 1 to mobile terminal X, has its own user; col. 8, lines 13-29);

means for receiving software from a software site (Fig. 1: 31; e.g. FTP server) on the network for storing the software into the dedicated storage area of the user (col. 6, lines 13-24; col. 9, line 57 – col. 10, line 54; col. 21, line 23 – col. 22, line 63);

a management table (Fig. 19, 550) storing therein management information about the software stored in the dedicated storage area of the user; and

means for referencing said management table in response to access from the user and

Art Unit: 2614

for sending the software, which is stored in the dedicated storage area of the user, to the portable data terminal of the user (col. 24, line 32 – col. 25, line 55).

Criss discloses means for receiving software, which is requested by the user of said portable data terminal from a software site on the network (col. 17, line 13 – col. 18, line 17). However, Criss does not disclose software which is purchase-requested by the user and receiving software from a software sales site on the network.

Regarding claim 8, Zilliacus further discloses a storage server (e.g. PC) connected to a portable data terminal over a network (col. 6, lines 14-17), said storage server comprising: a storage unit having a dedicated storage area uniquely allocated to an individual user of a portable data terminal; means for receiving software, which is purchase-requested by the user of said portable data terminal, from a software sales site the network for storing the software into the dedicated storage area of the user (col. 6, line 1 - col. 7, line 15); management information about the software stored in the dedicated storage area of the user; and means for referencing said management information in response to access from the user and for sending the software, which is stored in the dedicated storage area of the user, to the portable data terminal of the user (col. 6, lines 18-67; col. 7, line 27 – col. 8, line 3; col. 8, lines 52-60).

Zilliacus discloses a storage unit having a dedicated storage area uniquely allocated to an individual user of a portable data terminal and a management table (Fig. 2: 232, 238) stored external to the portable data terminal (col. 6, lines 18-67; col. 7, line 27 – col. 8, line 3). However, Zilliacus does not disclose a storage unit having dedicated storage areas, each uniquely

Art Unit: 2614

allocated to an individual user of a portable data terminal and said storage server comprising a management table.

Criss further discloses a storage server (e.g. host server) (Fig. 1: 30; col. 7, lines 1-14) connected to portable data terminals (Fig. 1, 36; col. 6, lines 1-11) over a network (Fig. 1), said storage server comprising:

a storage unit (Fig. 3b, 67) having dedicated storage areas, each uniquely allocated to an individual user of a portable data terminal (Fig. 4; col. 9, lines 57-67) (e.g. wherein each portable data terminal, for example: mobile terminal 1 to mobile terminal X, has its own user; col. 8, lines 13-29);

means for receiving software from a software site (Fig. 1: 31; e.g. FTP server) on the network for storing the software into the dedicated storage area of the user (col. 6, lines 13-24; col. 9, line 57 – col. 10, line 54; col. 21, line 23 – col. 22, line 63);

a management table (Fig. 19, 550) storing therein management information about the software stored in the dedicated storage area of the user; and

means for referencing said management table in response to access from the user and for sending the software, which is stored in the dedicated storage area of the user, to the portable data terminal of the user (col. 24, line 32 – col. 25, line 55).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the storage server of Zilliacus to include a storage unit having dedicated storage areas, each uniquely allocated to an individual user of a portable data terminal and said storage server comprising a management table as taught by Criss. One of ordinary skill in the art would have been lead to make such a modification to provide a plurality of portable data

Art Unit: 2614

terminals that can access the PC in order to store software that is specifically allocated for each portable data terminal in a multi-terminal environment and to provide a management table in the storage server to monitor a trial period of the software in the portable data terminal to prevent further downloads of the software from the portable data terminal.

Regarding claim 9, the storage server according to claim 8, wherein Zilliacus view of Criss s further discloses said storage unit further comprises a common storage area in which an application program body is stored as the software for common use by a plurality of users (Criss: Figs. 5a-5d) and wherein data associated with the application program body and corresponding to each user is stored separately in the dedicated storage area of the user (Criss: Fig. 4; col. 9, line 57 – col. 10, line 54).

Regarding claim 10, Zilliacus discloses a portable data terminal (Fig. 2, 210) with a network connection capability (col. 5, lines 10-16 and lines 38-40), comprising:
local storage (Fig. 2, 212) into which required software is downloaded from full-set software as required,
said full-set software being stored in a dedicated storage area allocated on a storage unit on a network (Fig. 2, 242; col. 5, lines 50-55);
management information associated with the software stored in the local storage is stored, wherein the management information includes at least expiration date information on the software (col. 6, lines 18-67; col. 7, line 27 – col. 8, line 3),
said portable data terminal further comprising means for automatically erasing the software from said local storage when an expiration date defined by the expiration date information has passed (col. 7, line 66 – col. 8, line 3; col. 8, lines 52-60).

Zilliacus discloses automatically erasing the software based on management information and a management table (Fig. 2: 232, 238) stored external to the portable data terminal (col. 6, lines 18-67; col. 7, line 27 – col. 8, line 3). However, Zilliacus does not disclose a portable data terminal comprising a management table.

Criss discloses a portable data terminal (Fig. 1, 36; col. 6, lines 1-11) with a network connection capability, comprising:
local storage (Fig. 2, 50) into which required software is downloaded from full-set software as required, said full-set software being stored in a dedicated storage area allocated on a storage unit on a network (Fig. 3b, 67; col. 7, lines 1-14);
a management table (Fig. 19, 550) in which management information associated with the software stored in the local storage is stored,
wherein the management information includes at least expiration date information on the software (col. 24, line 32 – col. 25, line 55),
said portable data terminal further comprising means for automatically upgrading the software from said local storage when an expiration date defined by the expiration date information has passed (col. 9, line 57 – col. 10, line 54).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the portable data terminal of Zilliacus to include a management table as taught by Criss. One of ordinary skill in the art would have been lead to make such a modification to provide a management table in the portable data terminal to monitor the trial period of the software in the local storage to determine an expiration date of the software.

Art Unit: 2614

Regarding claim 11, the portable data terminal according to claim 10, wherein Zilliacus in view of Criss further discloses means for allowing the user to rewrite said management table freely is not provided (e.g. updated through wireless communication from the host computer is allowed) (Criss: col. 24, line 32 – col. 25, line 55; col. 27, line 60 – col. 28, line 10).

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO-892 Form.

11. Any response to this action should be mailed to:

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Or faxed to:

(703) 872-9306 (for formal communications intended for entry)

Or call:

(571) 272-2600 (for customer service assistance)

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lisa Hashem whose telephone number is (571) 272-7542. The examiner can normally be reached on M-F 8:30-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (571) 272-7547. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-2600.

Art Unit: 2614

13. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

lh

November 16, 2006

FAN TSANG
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600

